



UNITED STATES PATENT AND TRADEMARK OFFICE

rw

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,031	01/18/2002	Michael Christopher Friel	08291-699001	6809

26211 7590 05/20/2004

FISH & RICHARDSON P.C.
45 ROCKEFELLER PLAZA, SUITE 2800
NEW YORK, NY 10111

EXAMINER

DODSON, SHELLEY A

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,031

Applicant(s)

FRIEL ET AL.

Examiner

SHELLEY A. DODSON

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on PRELIMINARY AMENDMENT FILED 1/18/2002.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-47 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 16-47 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SHELLEY A. DODSON
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Serial No. 09/889,031
Art Unit 1616

-2-

DETAILED ACTION

1.

Claims 1-15 have been cancelled in preliminary amendment. Claims 16-47 are pending in this application filed January 18, 2002.

2.

Applicant's claims are directed toward a combined insect repellent and sunscreen composition and the method of making the same.

Claim Rejections - 35 USC § 112

3.

Claim 16 is rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is confusing and indefinite because of applicant's use of the term "including". Said term makes the claim so indefinite that one cannot decipher it's meaning. The examiner of record suggests the terms "comprising", "consisting of" or

"consisting essentially of" as alternatives. Clarification is necessary in the above stated matter.

Claim Rejections - 35 USC § 103

4.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.

Claims 16-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,916,541, USP 6,159,452 and USP 6,284,227 all Stewart.

Stewart discloses a water resistant sunscreen and insect repellent composition of the process of making the same. In claim 3, Stewart discloses that the sunscreen composition if prepared by a method comprising the steps of preparing a water phase and preparing a oil phase by a two step process. Stewart further discloses in claim 3 that the two phases are further combined to form a stable emulsion. In column 4, lines 36-45, Stewart further

discloses that the insect repellent agent is specifically, N,N-diethyl-m-toluamide (DEET) in amounts ranging from 7% to about 33%. In column 4, Stewart discloses that the sunscreens are oxybenzone and octyl methoxycinnamate at claimed by applicant. Said sunscreens are in amounts from 2 to about 8%. In column 5, line 5, Stewart further discloses that inorganic sunscreens are zinc oxide and titanium dioxide in amounts of from 3% to about 5%. In column 5, line 11, Stewart discloses that PEG 40 stearate is present in amounts of 0.10% to about 0.20% by weight. In column 5, line 36, Stewart further discloses that 0.15% to about 0.30% of a natural thickener is also present, specifically a natural gum thickener. In column 5, line 50 through to column 6, line 29, patentee discloses employing film formers, more specifically tricontonyl PVP in an amount about 3%. In column 6, Stewart further discloses additional additive such as neutralizers, chelating agents, preservatives, moisturizers and perfumes are also present in the same amounts and proportions claimed by applicant. Also note all working Examples for further amounts and proportions. In column 7, lines 32-60 Stewart discloses that specific temperature ranges of the method steps. Stewart discloses each and every aspect of the invention as claimed by the applicant with the exception of combining the water and oil phase prior to adding the inorganic suncreening agents.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the water and oil phases of the prior art prior to the addition of the sunscreening agents in view of the teaching of the prior art that the order of combining said ingredients and that numerous changes in the details of the composition and method may be resorted to without departure from the scope or spirit of the invention. That the preference of the order of ingredients may be changed or altered through routine experimentation. This is in the absence of a clear showing of any unexpected results attributable to the order in which applicant is adding said ingredients for form the emulsion. Additionally, the examiner notes that said ingredients are the same and in the same amounts and proportions claimed by the applicant in the instant case.

Telephone Inquiries

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley A. Dodson whose telephone number is (571) 272-0612 and fax number (571) 273-0612. The examiner can normally be reached on Monday-

Serial No. 09/889,031
Art Unit 1616

-6-

Thursday from 7:30 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached at (571) 272-0602.

7.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. This new location should be used in all instances when faxing any correspondence numbers to Group 1600. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shelley A. Dodson
Primary Examiner
Art Unit 1616

May 17, 2004